

## **REMARKS**

Applicant respectfully requests consideration of the subject application as amended herein. This Amendment is submitted in response to the Office Action mailed February 23, 2006. Claims 13-20 have been withdrawn. Claims 1-12 are rejected. In this Amendment, Claim 1 has been amended.

### **Rejections under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 1-10 under 35 U.S.C. §103(a) as being unpatentable over Jain, et al., (USPN 5,3968,897, “Jain”) in view of Van Tassel, et al., (USPN 5,292,309, “Van Tassel”). For the reasons stated below, Applicant respectfully submits that Jain in view of Van Tassel does not make obvious claims 1-10.

Jain teaches a two tubes system to work in conjunction to measure a change in fluid pressure. Any one tube of Jain’s system cannot operate alone to indicate a change in pressure. More particularly, Jain teaches tube 1 and tube 2, each having an orifice 3 and 8, respectively (Figure 1A of Jain). When the orifices align, the device measures the hydrostatic fluid pressure to indicate contact, which is when the fluid placed within the lumen 7 of tube 2 is affected by the orifices 3 and 8 contacting the outside environment . In Jain, tube 2 is disposed snugly within tube 1 and tube 2 has a plugged distal tip 5. There is no opening in the distal tip area of the tube 2.

In Jain, the fluid is not being dispensed through the lumen of the tube 2 (as taught by Jain, tube 2 is plugged) thus, if any fluid was placed within tube 2, the fluid is not being dispensed at a constant rate. In any event, there is no fluid being dispensed at a constant rate

from one opening through another opening through the lumen of the tube 2.

Contrary to Jain, Applicant's claimed invention as recited in claims 1-10 discloses a one tube system that has a first opening and a second opening. The fluid is dispensed through the lumen from the second opening through the first opening at a constant rate. Thus, a dynamic fluid pressure is measured. Then, as the needle contact the tissue, the first opening becomes occluded, the fluid pressure changes and a first pressure change is measured. Then, at the needle penetrate deeper into the tissue, the aperture becomes occluded and a second pressure change is measured.

In more particular, Jain did not teach (claim 1, with emphasis),

a needle with a first opening and a second opening, said needle having a lumen extending therethrough and at least one aperture located a predetermined distance from said first opening;

a fluid pressure measurement assembly coupled with a portion of said needle to measure pressure of a fluid dispensed in said needle, said pressure measurement assembly configured to measure *a first pressure that is the pressure of said fluid as said fluid is dispensed through said needle at a constant rate*, a second pressure that is a pressure change when said needle contacts said tissue and said first opening becoming occluded, and a third pressure that is a second pressure change when as said needle penetrates said tissue and said aperture becoming occluded.

Even if the Examiner view tube 1 of Jain as compared to the claimed invention, tube 1 itself could have not been modified to provide a pressure change measurement as recited in the claims 1-10. There is no dynamic fluid pressure being measured as the fluid is dispensed at a constant rate through the needle. Further, tube 2 of Jain fits snugly within tube 1 thus, fluid flow would have not been contemplated. In any event, Jain's tube 1, equipped with orifice 3 requires tube 2 with orifice 8 to work in conjunction to detect pressure change. And even with such process, there is no fluid being dispensed so that the change in the dynamic fluid pressure is measured to indicate penetration depth.

Thus, even if Van Tassel disclosed a surgical depth measuring instrument as the Examiner has asserted, combining Van Tassel to Jain does not provide the elements of claims

1-10.

For at least the reason above, Applicant respectfully submits that Jain does not make obvious claims 1-10 and earnestly requests the Examiner to withdraw the rejection.

The Examiner has also rejected claims 11-12 as being unpatentable over Jain in view of Van Tassel in further view of Clarke (US PUB 2005/0027199 A1, "Clarke") or Stoller, et al., (US PUB 2004/0171933A1, "Stoller") or Freeman, et al., (US PUB 2003/0083686A1, "Freeman").

Similar to previously discussed, even if Van Tassel, Clarke, Stoller, or Freeman discloses a computer processor coupling to a measuring assembly, combining any of the above references would have not provide the elements of claims 11-12 since none of the references taught

a needle with a first opening and a second opening, said needle having a lumen extending therethrough and at least one aperture located a predetermined distance from said first opening;

a fluid pressure measurement assembly coupled with a portion of said needle to measure pressure of a fluid dispensed in said needle, said pressure measurement assembly configured to measure *a first pressure that is the pressure of said fluid as said fluid is dispensed through said needle at a constant rate*, a second pressure that is a pressure change when said needle contacts said tissue and said first opening becoming occluded, and a third pressure that is a second pressure change when as said needle penetrates said tissue and said aperture becoming occluded.

as discussed.

For at least the reason above, Applicant respectfully submits that Jain with Van Tassel, Clarke, Stoller, or Freeman do not make obvious claims 11-12 and earnestly requests the Examiner to withdraw the rejection.

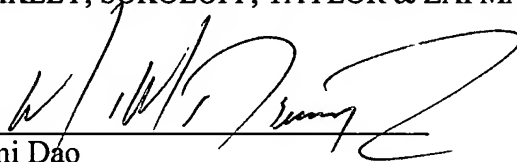
If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, Applicant respectfully requests the Examiner to contact Mimi Diemmy Dao at (408) 720-8300.

**Deposit Account Authorization**

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

A handwritten signature in black ink, appearing to read 'Mimi Dao', is written over a horizontal line.

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